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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,287	09/08/2003	William A. Clark	Deluxe 2060	1382
33717 7590 04/05/2007 GREENBERG TRAUIG LLP 2450 COLORADO AVENUE, SUITE 400E SANTA MONICA, CA 90404			EXAMINER CALLAHAN, PAUL E	
			ART UNIT 2137	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/657,287

Applicant(s)

CLARK ET AL.

Examiner

Paul Callahan

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 25-28 is/are allowed.
- 6) ☐ Claim(s) 1-7, 14-16, 19-22, 24, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) 8-13, 17, 18 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9-8-03, 3-31-05.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 are pending in the instant application and have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 16-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a motion picture film print or copy print bearing coded information in the form of visible marks made to resemble defects.

The claims are directed towards a film print containing image data and coded marks. The film constitutes a mere compilation of data. The claims are therefore directed towards only an "abstract idea," something which falls outside the permitted statutory classes of invention eligible for the grant of a US Patent.

The claimed film print and copy print containing the coded marks, even when played, does not cause a change of state of a processor or other object without the presence of an associated playback apparatus, configured as set forth in the applicant's disclosure to detect the coded marks and subsequently undertake processing steps based upon the information coded for by the marks. Therefore the claimed film print or copy print, even though they may contain the coded marks set forth in the claim

Art Unit: 2137

language, do not represent a "practical application" of an abstract idea, and therefore are not a judicial exception to the requirements of 35 USC 101.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-7, 16, 19-22, 24, 29, and 30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ryota et al., International Application EP 0 899 688 A3.

As for claim 1, Ryota teaches a moving picture security code application system (para. 57) comprising: (a) code symbol recording equipment for recording code symbols on a moving picture record medium (fig. 2; [0001], [0033]), and (b) a control system for controlling said recording equipment to cause it to record on said record medium (fig. 2, [0023]) information comprising a plurality of separate coded symbols ([0043], [0049]), each being recorded in a separate frame of said moving picture ([0033], [0034], [0035]).

As for claim 2, Ryota teaches a system as in Claim 1 in which each of said code symbols is located in a visible portion of said frame, said symbol comprising one or more small marks which look like defects ([0051]: a magnifying glass must be used to

discern that the mark is a coding symbol).

As for claim 3, Ryota teaches a system as in Claim 1 in which each of said symbols is made of a plurality of specks formed into a pattern representing an alphanumeric character (fig. 10, 17, 18, 19, [0076], [0078], [0095]).

As for claim 4, Ryota teaches a system as in Claim 3 in which each of said specks has a size large enough to avoid elimination by the data compression routine of a video camera used to make a copy of the motion picture recorded on said record medium, said specks being relatively small and widely spaced from one another so as to be unobtrusive ([0049]).

As for claim 5, Ryota teaches a system as in Claim 1 in which each of said symbols is recorded in a plurality of different adjacent frames prior to the location of the next component of said symbol ([0097]).

As for claim 6, Ryota teaches a system as in Claim 1 in which each of said symbols is recorded a plurality of times at spaced-apart locations on said record medium ([0034], 0035]).

As for claim 7, Ryota teaches a system as in Claim 1 in which each of said symbols comprises a representation of one digit of a multi-digit print identification

Art Unit: 2137

number, and a unique identification number is provided for each of a plurality of prints of a moving picture ([0095]: the copyright control information is chosen pseudo-randomly and therefore each will be unique to that print).

As for claim 16, Ryota teaches a motion picture film copy bearing a coded identification number with a plurality of different components (fig. 2; [0001], [0033], fig. 10, 17, 18, 19, [0076], [0078], [0095]), each of said components being composed of one or more small, separated marks resembling defects and located in the visible portion ([0051]) of a separate one of the frames of said film copy ([0034], 0035)).

As for claim 19, Ryota teaches a film copy as in Claim 16 in which each of said components is repeated at least once in an adjacent frame before a second component is recorded ([0097]).

As for claim 20, Ryota teaches a film copy as in Claim 16 in which each of said components is repeated at least once before a second component is recorded and in which said symbol is repeated at spaced intervals along said film ([0097]).

As for claim 21, Ryota teaches a film copy as in Claim 16 in which said separate ones of said frames are located a substantial distance from the other of said frames ([0097]).

As for claim 22, Ryota teaches a motion picture film print bearing coded information (fig. 2; [0001], [0033]), said coded information being represented by a plurality of small marks having the appearance of defects formed into code symbols representing said coded information defects ([0051]: a magnifying glass must be used to discern that the mark is a coding symbol).

As for claim 24, Ryota teaches a film print as in Claim 22 in which said marks comprise a plurality of groups of defects, each arranged in a predetermined pattern or shape representing a separate digit of the print number of the film ([0095]).

As for claim 29, Ryota teaches a method of recording coded alphanumeric in a motion picture film print ([0095]), said method characters comprising; (a) recording a separate predetermined pattern or defects in the sight area of one or more frames of said film to represent each of said characters ([0095]), and (b) storing the location in said film of each of said patterns ([0051]).

As for claim 30, Ryota teaches a method as in Claim 30 in which said defects are small specks, each pattern appearing in one of widely separated frames to form an alphanumeric sequence representing the code number of said film ([0095]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryota.

As for claim 13, Ryota fails to explicitly teach a system as in Claim 1 in which said recording equipment includes fiber-optic cables with an exit focusing lens and a controlled light source for sending light through selected ones of said fiber-optic cables to record a pattern of light spots on said record medium and thereby form one of said symbols. However, Official Notice may be taken that that use of such features in recording equipment is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ryota. It would have been desirable to do so since this would allow for the use of standard film recording apparatus to encode the watermarked code symbols.

As for claim 14, Ryota does not explicitly teach a system as in Claim 13 in which said recording equipment includes means for synchronizing the formation of said spots

Art Unit: 2137

with the movement of said record medium through a copy recorder for recording medium. However, Official Notice may be taken that that use of such features in recording equipment is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the system of Ryota. It would have been desirable to do so since this would allow for the use of standard film recording apparatus to encode the watermarked code symbols.

As for claim 15, Ryota teaches a system as in Claim 14 in which said record medium is motion picture film and said copy recorder is a film printer (fig. 2; [0001], [0033]).

Allowable Subject Matter

8. Claims 25-28 are allowed.
9. Claims 8-12, 17, 18, and 23, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
10. The following is a statement of reasons for the indication of allowable subject matter: the closest prior art in the field does not teach the combination of features of the

Art Unit: 2137

claims invention, particularly including:

As for claims 8, 18, and 23, a system as in Claim 1 in which each of said symbols is composed of one or more small marks made to look like a defect selected from the group consisting of dirt or dust particles; scratches; and color defeats.

As for claims 9, 12, and 18, the size constraints set forth in the claim language.

As for claims 10 and 17, recording said identification number on said leader.

Claim 11 is dependent on claim 10 and is allowable on that basis.

As for claim 25, keeping a record of the identification number for a copy of a print and the destination to which it was delivered; viewing a suspected counterfeit copy of said film and determining the copy identification number recorded in said suspected counterfeit copy; and tracing said copy to said destination to which the copy was delivered. Claims 26-28 are dependent on claim 25 and are thereby allowable on that basis.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents teach systems of film watermarking similar to that of the Applicant:

Venkatesan et al. US 6,975,743

Linnartz US 6,131,161

Ryan US 5,574,787

Ryan US 5,315,448

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Application/Control Number: 10/657,287

Page 11

Art Unit: 2137

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER